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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,233	08/03/2001	Simon Erani	4061.007	8232

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EXAMINER

KIM, JENNIFER M

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/922,233

Applicant(s)

ERANI, SIMON

Examiner

Jennifer Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,7,20,25 and 33-36 is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-19,21-24,26-32 and 37-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The amendment filed April 21, 2005 have been received and entered into the application.

#### **Communication**

Applicant's response that inadvertent error of missing claim 30 is noted. Therefore, the numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 31-41 been renumbered as 30-40, respectively.

#### **Action Summary**

The rejection of record 1, 3-6, 8-19, 21-24, 26-32 and 37-40 under 35 U.S.C. 103(a) as being unpatentable over "Brooks Industries, inc. Cosmetic Ingredients &

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Ideas Protein Bonded Vitamins" (Brooks II) in view of French Patent 2746008 ('008) is being maintained for the reasoned stated in the previous office action.

Claims 2, 7, 20, 25 and 33-36 are allowed.

### ***Response to Arguments***

Applicant's arguments filed April 6, 2005 have been fully considered but they are not persuasive. Applicant argues that there is no teaching or suggestion has been cited with respect to the references taken as a whole as to why one of ordinary skill would disregard the teachings of the Brooks II reference to use its VITAZYME C form recommended therein and it is not at all apparent why one of ordinary skill would formulate the claimed a composition by accepting the teachings of Brooks II to use some of the VITAZYME vitamin forms therein, but then reject its teaching to use the other, the VITAZYME C form. This is not persuasive because the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is clear that all the active agents are well- known by Brooks II and French Patent as vitamins to formulate cosmetics for the skin and skin cosmetics to protect degradation of collagen. Therefore, one would have

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been motivated to combine these teachings and make such modification because they are drawn to same technical fields (constituted with same utility in cosmetic art and well known actives (e.g. vitamins)), and pertinent to the problem which applicant concerns about. MPEP 2141.01(a). Applicant argues that the two vitamin forms in combination is relatively uncommon, and the two together being an even more unexpected combination. This is not persuasive because the two forms of vitamins are well known by the cited references for cosmetic skin care use. The motivation for combining the components flows from their individually known common utility (see *In re Kerkhoven*, 205 USPQ 1069(CCPPA 1980)). Thus, the claims fail to patentably distinguish over the state of the art as represented by the cited references.

In view of the above, the Office Action of April 15, 2005 is deemed proper and asserted with full force and repeated herein to obviate applicant's claims and for Applicant's convenience.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3-6, 8-19, 21-24, 26-32 and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Brooks Industries, inc. Cosmetic Ingredients & Ideas<sup>R</sup> Protein Bonded Vitamins" (Brooks II) in view of French Patent 2746008 ('008).

Brooks II teaches that compounds a and c-d are well known vitamins to formulate cosmetics for the skin. The difference between applicant's claimed invention, as argued in his remarks, is the lack of ascorbylmethylsilanol pectinate, in a cosmetic formulation. However, one of ordinary skill in the art would have been motivated to use this uncommon vitamin in a cosmetic formulation as taught by Brooks II since '008 teaches at page 4, that Ascorbosilane C, applicant's ascorbylmethylsilanol pectinate, is used in skin cosmetics to protect degradation of collagen.

As stated in *In re Kerkhoven*, 626 F.2d 846, 205 USPQ 1069, at page 1072 (CCPA 1980):

"It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose. *In re Susi*, 58 CCPA 1074, 1079-80, 440 F.2d 442, 445, 169 USPQ 423, 426 (1971); *In re Crockett*, 47 CCPA 1018, 1020-21, 279 F.2d 274, 276-277, 126 USPQ 186, 188 (CCPA 1960).

As this court explained in *Crockett*, the idea of combining them flows logically from their having been individually taught in the prior art. "

In this application it would have been prima facie obvious to include applicant's claimed ascorbylmethylsilanol pectinate in the skin formulation of known agents which are used in the treatment of skin conditions.

Claims 6, 8-10 18, 24, 26-28 and 40 which recite the addition of glycolic acid to the formulation is within the skill of the art is illustrated in the patent to Zaveri (5,958,437). At column 2, lines 47-56 it is taught to be used as a stabilizer in a cosmetic composition for the skin.

Claims 11-14 which recite various means of applying the claimed composition to the skin is also within the skill of the art column 4, line 48 to column 5, line 61 as illustrated in the patent to Fotinos (6,346,255). At column 4, lines 48-59 the concentrations of claims 15-17, 32 and 38-39 the concentrations of cosmetic formulations are shown to be common to the art. This extrinsic evidence establishes that it was known to the art to use glycolic acid and the concentration in formulating cosmetics with a reasonable expectation of success.

The test of obviousness is "whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention." In re Gorman, 933 F.2d 982, 18 USPQ 2d 1885, (Fed. Cir. 1991). In view of the above rejection it is deemed that the evidence presented has established a prima facie case of obviousness. is presented.

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Kim whose telephone number is 571-272-0628. The examiner can normally be reached on Monday through Friday 6:30 am to 3 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sreenivasan Padmanabhan  
Supervisory Examiner  
Art Unit 1617

Jmk  
July 6, 2005